

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Final Rejection, dated August 26, 2003. Claims 1-49 were originally filed with the application on June 2, 2000. New claim 50 was added in the Amendment, dated June 27, 2003. Claims 1-50 are currently pending. Claims 1, 8, 15, 20, 22, 27, 30, 37, 41, 45 and 50 are independent.

Rejection Under 35 USC § 102(e)

In the Final Rejection, claims 1-17 and 19, 22-36, and 50 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,141,010 to Hoyle et al. ("Hoyle"). Applicant respectfully submits that in forming this rejection the Examiner has again improperly combined detached concepts described in Hoyle as applied to the subject claims of the present application. Furthermore, applicant submits that the claims, as amended, present novel features not disclosed by Hoyle. Thus, applicant submits that the claims, as amended, are in allowable form.

Generally speaking, one benefit among many of the method and system of the claims is that a software application namely a downloadable toolbar application having a toolbar interface that is integrated into an interface of a browser application, can be customized according to user preferences without the need to hard code the customization options into the toolbar application itself. For example, another benefit among many of the method and system of the claims is that the toolbar application can be upgraded without overwriting any of the actual programming code of the toolbar application. Such a method and system has numerous advantageous that have been set forth in the present application.

In rejecting the claims of the present application over Hoyle, the Examiner has improperly pulled portions of two discrete and unrelated concepts from Hoyle and patched those portions together in piecemeal fashion in an attempt to arrive at the claimed method and system. Specifically, Hoyle describes two processes for performing two wholly separate acts. First, Hoyle describes a method of targeting advertising to its users. This method includes obtaining

user preferences and recording usage of a software application, namely which web sites a user links to, to target advertising. The other, unrelated method, involves a method of updating a software application through inclusion of a "builder module" that periodically, and without user input, compares the version numbers of the modules on the user's computer with modules stored at the server. If newer modules are stored at the server, the new modules are downloaded and the older modules are overwritten. As discussed in detail below, neither of these processes described in Hoyle discloses the claimed method and system, and the Examiner has improperly combined selected steps of the processes in an attempt to arrive at the claimed invention. Applicant respectfully submits that this use of a reference is improper.

1. Rejection of Independent Claim 1

The Examiner asserts that Hoyle discloses each and every element of independent claim 1 of the present application. In particular, the Examiner contends that arbitrarily selected steps of Hoyle's method of maintaining/updating modules of a software application combined with arbitrarily selected steps of a wholly disparate method for targeting advertising discloses the elements of independent claim 1.

(a) Hoyle Does Not Disclose A Downloadable Toolbar Application Including A Toolbar Interface That Is Integrated Into A Browser Application Interface.

Applicant has amended claim 1 to more particularly point out that the software application is a:

[d]ownloadable toolbar application downloaded from a server to a client computer and installed on the client computer, the downloadable toolbar application having a toolbar graphical interface that is integrated in to a browser application user interface of a browser application, such that the toolbar graphical interface becomes part of the browser application user interface.

See Preamble of Amended Claim 1. Claim 1 has been further amended to indicate that the graphical toolbar interface has a language attribute. Thus, as amended, claim 1 sets forth a

method of managing the resources of a downloadable toolbar application in which a language attribute of a graphical toolbar interface may be changed in response to a change in user preference. Upon such a change in user preference, a message, as referred to in step (b) of claim 1, as amended, indicating the change in user preference is received at the server system.

In the June 27, 2003 Amendment, it was argued that the "request" was a message transmitted to the server system indicating a change in user preference or a change in user. Applicant wishes to clarify that this message may be any message transmitted to or received by the server system indicating a change in user preference. By way of non-limiting example, the message may involve the user accessing a preference web page, as shown in FIG. 8, and changing his/her preference. Moreover, by way of non-limiting example, the message can be the detection of a new user with different preferences logging into the web site supporting the downloadable toolbar application. See Specification at pp. 18-19.

In response to the message, the server system transmits a preference parameter to a resource manager operative on the client computer so that the resource manager can determine whether the needed group of resources necessary to effect the desired change in the language attribute is stored locally at the client computer. See Step (d) of claim 1, as amended. If the needed group of resources is not stored locally, then the resource manager requests the resources from the server system. See Step (e) of claim 1, as amended.

Applicant respectfully submits that Hoyle does not disclose the downloading of a discrete toolbar application that has an interface that is controlled by a remote server system and is integrated into a separate browser application user interface. Hoyle, in contrast, describes only downloading a standalone software application. There is no description in Hoyle of downloading a toolbar application that is controlled at least in part by a predetermined, remote server system and comprises a graphical toolbar interface that is integrated into and becomes a part of the user interface of a browser application, such as, for example, Internet Explorer or

Netscape Navigator. While Hoyle describes a toolbar 80 that is part of the software program 10, the toolbar 80 is not a separate software application that is downloaded separately from the software program 10 of Hoyle and integrated into the software program 10 as set forth in claim 1, as amended. Instead, toolbar 80 is merely an original component of the software program 10 of Hoyle that is upgradeable along with the software program 10 of Hoyle. Thus, the description in Hoyle of toolbar 80 does not disclose the downloadable toolbar application of claim 1. Hoyle is devoid of any teaching or suggestion of downloading a toolbar application that modifies a browser application, which toolbar is in turn modifiable as claimed.

Because this element of claim 1, as amended, is not disclosed by Hoyle, Applicant respectfully submits that the rejection under 35 U.S.C. § 102(e) has been overcome. Nor would Hoyle render the claimed limitation obvious, since there is no teaching or suggestion in Hoyle, or any other reference of record, to provide the missing claim elements. See also the arguments directed to the proposed combination of Hoyle and Hetherington.

(b) Hoyle Does Not Disclose The Claimed Process Of Changing A Language Attribute Of A Downloadable Toolbar Application Interface In Response To A Change In User Preference.

Hoyle is further directed to a system for targeting advertising to a user of a computer through an application provided with access to information resources via the Internet. A separate and discrete concept described by Hoyle concerns a system and method for maintaining and updating the application. The following description from Hoyle explains this process:

This upgrading process is implemented automatically by the client software application without requiring any user input or initiation of the process.

See Hoyle, col. 14, lines 6-8.

This update capability can be programmed into the GUI module 12 (or, possibly, into ADM module 14) so that it periodically checks with server 22 for an updated ADM module 14 and, if found,

downloads the new program and installs it as necessary. This can be done automatically without the client software application requiring any user input, if desired.

See Hoyle, col. 7, lines 52-58. In contrast, the message of claim 1, as amended, is received by the server system in response to an indication by the user that a change to the language attribute of the toolbar application is needed. As such, in contrast to automatic version update process of Hoyle, the request is received by the server system in response to some action of the user indicating a change in user preference.

In the Final Rejection, the Examiner points to several portions of Hoyle for the proposition that Hoyle discloses the generation of a request to change the application in response to a change in user preference. Applicant submits that these portions of Hoyle do not disclose the feature of "receiving at the remote server system a message to change the language attribute of the downloadable toolbar interface in response to a change in user preference" as set forth in claim 1, as amended. Applicant addresses each of the Examiner's cited portions in turn below.

1. Hoyle, Col. 5, lines 24-25

This passage in the Summary of the Invention section of Hoyle describes only a method for supplying demographically-targeted advertising involving the "transfer of a copy of the software to the computer in response to a download request by the user." See Hoyle, col. 5:24-25. The "software" referred to in this section is the software application itself that supports the delivery and display of advertising content to the user. Thus, the request to download this software is not akin to the message of claim 1, as amended, to change the language attribute of the toolbar interface in response to a change in user preference, because the request of Hoyle is not triggered by a change in user preference. Rather, the request of Hoyle is simply a request to download the software application from the remote server. Accordingly, the request of Hoyle, col. 5:24-25, is not the message of claim 1, as amended.

2. Hoyle, Col. 11, lines 57-67

This portion of Hoyle describes the detection of a user's interaction with other programs that may be implemented in the Windows™ operating system using a "system hooks" method. By detecting these inputs, the key event component 108 of the software application of Hoyle can determine whether to change the targeted advertising in response to the user input, not the user interface of the Hoyle application. See Hoyle, col. 11:60-63.

Thus, this section does not disclose the receipt of a message to change the language attribute of the toolbar interface in response to a change in user preference as in claim 1, as amended, at least because: (i) the detection of user input or interaction with other programs by the software application on the user's computer is not a message that is received at a remote server system; (ii) the user input or interaction is not "a message to change the language attribute of the downloadable toolbar interface"; and (iii) the user input or interaction is not an indication of a change in user preference, indicative of a need to change a toolbar interface, but rather indicative of the manner in which a user is using certain other programs. Accordingly, col. 11, lines 57-67 of Hoyle do not disclose the method of claim 1, as amended, as suggested by the Examiner.

3. Hoyle, col. 16, lines 44-48

This passage from Hoyle describes the transmission of user actions to "ADM server 22 or some other advertising data as posted form data, with the server using the data to select and download an appropriate advertisement". See Hoyle, col. 16:44-48. In contrast to claim 1, as amended, the user actions referred to in this passage are not "a message to change the language attribute of the downloadable toolbar interface in response to a change in user preference or a change in user".

Instead, the user actions being referred to are the user's interactions with the software application 10 or with other applications or the operating system operating on the user's computer. See Hoyle, col. 11:50-12:4; 12:26-46. These interactions may include the launching

of a browser application or other usage of applications on the user's computer system. These interactions, thus, are not indicative of a change in user preference and, in particular, and clearly not indicative of a change in user preference relating to a language attribute of a downloadable toolbar interface. Accordingly, 16, lines 44-48 of Hoyle do not disclose the method of claim 1, as amended, as suggested by the Examiner.

4. Hoyle, col. 16, lines 59-63

This passage describes only a request for and subsequent sending of "a form" to be filled out by a user. The form is used to collect demographic data about the user. See Hoyle, col. 16;53-56. The request for the form, thus, is not a request to change a language attribute of the toolbar interface and is not indicative of a change in user preference. Instead, the form is used to collect preliminary demographic data about a user in exchange for the ability to download the software application 10. See Hoyle, col. 16, lines 53-56.

Accordingly, col. 16, lines 59-63 of Hoyle do not disclose the method of claim 1, as amended, as suggested by the Examiner. Nor would Hoyle render the claimed limitation obvious, since there is no teaching or suggestion in Hoyle, or any other reference of record, to provide the missing claim element. See also the arguments directed to the proposed combination of Hoyle and Hetherington.

(c) Hoyle Does Not Disclose The Claimed Process Of Receiving Into The Client Computer From The Server System A Preference Parameter Associated With A Group Of Resources Needed To Accommodate The Request To Change The Language Attribute Of The Downloadable Toolbar Application.

The Examiner contends that the process shown in FIG. 8, steps 140-142 of Hoyle discloses the claimed step of receiving into the client computer from the server system a preference parameter associated with a group of resources needed to accommodate the request to change the language attribute of the downloadable toolbar application. See claim 1, as amended,

step (c). In particular, the Examiner contends that “demographic data provided to convey user preferences/settings and associated ID sent by server to user in response thereto is equivalent to receiving a preference parameter associated with data to be downloaded”.

Applicant respectfully submits that steps 140-142 of FIG. 8 of Hoyle do not disclose the transmission of a preference parameter associated with a group of resources needed to accommodate the request to change the language attribute of the downloadable toolbar application. Steps 140-142 of FIG. 8 of Hoyle describe only the process of receiving demographic data from a user desiring to download the software application 10, assigning a unique ID to the user, and storing the unique ID along with the collected demographic data. See Hoyle, cols. 16:53-17:25. While it is true that the unique ID is associated with the collected demographic data, the ID of Hoyle is not associated with a preference parameter that is associated with a needed group of resources that is needed to accommodate a requested change in the language attribute as set forth in claim 1, as amended. The ID and preference data of Hoyle is not used to modify the Hoyle software application 10, but merely to select content to the user. As described on the specification of the present application, the server system determines which group of resources are needed to accommodate the requested change in language attribute. The server system then identifies a preference parameter that is associated with the needed group of resources and transmits the preference parameter to the client system. The resource manager at the client system then uses the preference parameter to determine whether the needed group of resources is stored locally at the client computer.

Thus, the preference parameter of claim 1, as amended, is different from the unique ID of Hoyle, at least because the claimed preference parameter identifies a specific group of resources useable by the downloadable toolbar application, whereas the unique ID of Hoyle identifies a user and an associated set of demographic data not used by software. As such, Applicant

submits that steps 140-142 of FIG. 8 of Hoyle does not disclose step (c) of claim 1, as amended, of the present application.

(d) Hoyle Does Not Disclose The Claimed Process Of Modifying The Toolbar Graphical Interface Of The Downloadable Toolbar Application Using The Needed Group Of Resources To Reflect The Request To Change The Language Attribute Of The Downloadable Toolbar Application.

Hoyle describes a process by which targeted advertising can be delivered to a user of a software application 10. Nothing in Hoyle discloses modifying any aspect of the interface of a downloadable toolbar application, much less to reflect a requested change in the language attribute of the toolbar application. The Examiner concedes this point at pages 12 and 13 of the Final Rejection:

Hoyle discloses [that] the client computer receives [a] geographic or regional-specific preference parameter from the server system **but fails to disclose that the preference parameter is a language setting.**

(emphasis added).¹

Applicant also submits that Hoyle does not disclose the claimed step of modifying the toolbar graphical interface to reflect the requested change to the language attribute of the toolbar application. The rotation of banner advertisement graphics described in Hoyle does not relate to a change in the software application 10 of Hoyle. Moreover, from the description in Hoyle, such a change is not even contemplated. Thus, Hoyle does not disclose step (e) of claim 1, as amended.

Hoyle thus fails to disclose, teach or suggest each and every step of claim 1, as amended, and accordingly, Applicant respectfully submits that claim 1, as amended, is neither anticipated

¹ The Examiner repeatedly refers to the "preference parameter" of the claims as a preference setting or language setting. Applicant wishes to clarify that the preference parameter is an identifier that is associated with a group of resources that may be made available to the toolbar application, and not the setting of the user's preference.

nor obvious over Hoyle and is in condition for allowance and requests that the Examiner withdraw the rejection.

2. Rejection of Dependent Claims 2-7

In light of the amendment and arguments set forth above in connection with independent claim 1, Applicant respectfully submits that dependent claims 2-7 are also allowable as depending from an allowable base claim.

3. Rejection of Independent Claim 8

The Examiner contends that Hoyle discloses each element of independent claim 8 for the same reasons as discussed in connection with claim 1 of the present application. Further, the Examiner asserts that Hoyle discloses “that the group of resources is geographic region-specific (i.e., internationalizing) and the application has characteristics related to user’s region of interests.” Applicant submits that this rejection has been overcome for the same reasons as discussed above in connection with claim 1, as amended.

Specifically, Applicant has amended claim 8 to set forth the (a) downloading from a remote server the downloadable toolbar application, and (b) installing the downloadable toolbar application on a client computer wherein upon installation a toolbar interface of the downloadable toolbar application becomes a part of a browser application interface and wherein the toolbar interface has a language specific attribute. Furthermore, claim 8 has been amended to set forth that the language-specific group of resources are retrieved from the server system if the needed language-specific group of resources is not stored locally on the client computer so as to provide the language-specific group of resources to the downloadable toolbar application to enable the generation of a graphical user interface incorporating the desired language.

These features are not disclosed, taught or suggested by the Hoyle reference, and accordingly, in light of the above and the additional arguments made in connection with claim 1,

as amended, Applicant submits that claim 8 is neither anticipated nor obvious over Hoyle and is also in condition for allowance.

4. Rejection of dependent claims 9-14

In light of the amendment and arguments set forth above in connection with independent claims 1 and 8, Applicant respectfully submits that dependent claims 9-14 are also allowable as depending from an allowable base claim.

5. Rejection of Independent Claim 15

In rejecting independent claim 15, the Examiner makes essentially the same arguments addressed above in connection with independent claims 1 and 8, which as discussed above have be overcome by the present amendments to the claims.

Claim 15 has been amended along the same lines as claims 1 and 8 and, therefore, Applicant respectfully submits that the arguments submitted above apply equally here, the rejection to claim 15 has been overcome, and requests that the Examiner withdraw the rejection of claim 15.

6. Rejection of dependent claims 16-17 and 19

In light of the amendment and arguments set forth above in connection with independent claims 1, 8, and 15, Applicant respectfully submits that dependent claims 16-17 and 19 are also allowable as depending from allowable base claims.

7. Rejection of Independent Claim 22

Applicant respectfully submits that claim 22 is in allowable form at least as a result of the distinctions discussed above in connection with claims 1, 8, and 15.

In rejecting claim 22, however, the Examiner attempts to compare the updating of banner ads displayed by the software application 10 (see Hoyle, col. 9, lines 52-64) to the generation of the toolbar interface of the claims of the present application. As amended, claim 22 claims the integration of a toolbar interface into a user interface of the browser application such that the

toolbar interface graphically appears to be a part of the browser interface. As explained above, the Hoyle toolbars 76 and 80 are native components of the downloaded software application 10, as opposed to a separate toolbar application that is integrated into an existing browser application as set forth by the claims of the present application. Hoyle does not make any disclosure of using either the software application 10 or the toolbars 76 and 80 as downloadable components that are integrable into existing applications of the user.

Accordingly, based on the arguments set forth above in connection with claims 1, 8, and 15, Applicant respectfully requests that the Examiner withdraw the rejection of claim 22.

8. Rejection of dependent claims 23-26

In light of the amendment and arguments set forth above in connection with independent claims 1, 8, 15, and 22, Applicant respectfully submits that dependent claims 23-26 are also allowable as depending from allowable base claims.

9. Rejection of Independent Claim 27

Claim 27 has been amended to further recite that upon a change of preference by a user relating to a customizable language option, the resources needed by a toolbar application having a toolbar interface that is integrated into a browser user interface of the browser application to process the change are retrieved from the server system, and the customized, language-specific toolbar interface of the toolbar application browser interface is generated using the retrieved resources. Hoyle does not disclose the method of claim 27, as amended, at least in light of the distinctions discussed above in connection with claims 1, 8, 15, and 22.

Applicant thus respectfully requests that the Examiner withdraw the rejection of claim 27, as amended.

10. Rejection of Dependent Claims 28-29

In light of the amendment and arguments set forth above in connection with independent claims 1, 8, 15, 22, and 27, Applicant respectfully submits that dependent claims 28-29 are also allowable as depending from allowable base claims.

11. Rejection of Independent Claim 30

Applicant respectfully submits that claim 30, as amended, is in allowable form at least as a result of the distinctions discussed above in connection with claims 1, 8, 15, and 22.

Moreover, Hoyle fails to disclose a method of updating/modifying a toolbar interface of a toolbar application wherein the toolbar application can be modified or updated without the need to restart both the toolbar application and the native browser application of which the toolbar application is integrated into. In contrast, Hoyle teaches downloading newer application modules to the client system and overwriting the older modules. In such a system, it would be necessary to restart the application in order to take advantage of the newer modules features.

Thus, Hoyle does not disclose, teach or suggest the method of claim 30, as amended, and thus claim 30 is neither anticipated nor obvious over Hoyle. Applicant requests that the rejection be withdrawn.

12. Rejection of Dependent Claims 31-36

In light of the amendment and arguments set forth above in connection with independent claims 1, 8, 15, 22, 27, and 30, Applicant respectfully submits that dependent claims 31-36 are also allowable as depending from allowable base claims.

13. Rejection of Independent Claim 50

Applicant respectfully submits that claim 50, as amended, is in allowable form at least as a result of the distinctions discussed above in connection with claims 1, 8, 15, and 22.

Furthermore, the Examiner points to Hoyle, col. 9, lines 52-64 as disclosing an Internet browser toolbar displayed as part of an Internet browser interface. This passage only describes the presentation of graphical advertisements in an information display region of the software

application. The cited passage of Hoyle also describes a toolbar that contains links to other programs installed on the user's computer using existing desktop shortcuts. This toolbar, however, is not integrable into any other software program other than software application 10.

The passage directly preceding the cited passage, namely Hoyle, col. 9, lines 46-52, specifically states that software application 10 is separate and distinct from any other applications, including a browser application:

URL field 74 is a conventional drop-down input box that can be used for entering URLs or path and file names of locally-stored web pages. **Once a user has entered a web page location into this field and pressed Enter, GUI module 52 initiates operation of the user's default browser and directs it to access and display the specified web page.**

(emphasis added); see also Hoyle, col. 12, lines 26-46. These statements in Hoyle make clear that the software application 10 and its constituent parts, namely the advertising region 78 and toolbars 76 and 80, are not made a part of an existing browser application.

Thus, Hoyle does not disclose, teach or suggest the method of claim 50, as amended, and thus claim 50 is neither anticipated nor obvious over Hoyle. Applicant requests that the rejection be withdrawn.

Rejections under 35 U.S.C. § 103(a)

In the Final Rejection, the Examiner rejected claims 18, 20-21, and 37-49 under 35 U.S.C. § 103(a) as being unpatentable over the hypothetical combination of Hoyle in view of U.S. Patent No. 6,407,754 to Hetherington et al. (hereinafter "Hetherington").

The Examiner contends that Hoyle discloses the basic features of claims 18, 20, 21, and 37-49. The Examiner has essentially applied the same rationale underlying the rejection of claim 1 to claims 18, 20, 21, and 37-49. However, the Examiner concedes that Hoyle does not disclose that the preference parameter is a language preference. The Examiner further concedes that Hoyle does not specify that the selected change in the language preference is caused by a second

user, with a different language preference than the first user's language preference, logging onto the system.

Nevertheless, the Examiner asserts that Hetherington discloses the switching of a language context based on messages—citing to FIGS. 2a-b; col. 2, lines 20-38. The Examiner thus contends that it would have been obvious from the demographic customizing of Hoyle for one of ordinary skill in the art to modify the demographic preference of Hoyle so as to include a language preference as taught by Hetherington to enable variations and language. In making the rejection, the Examiner appears to contend that Hoyle suggests the accommodation of demographic differences by providing a unique parameter associating user-specific demographic data with the sending of ad graphics – citing to Hoyle, col. 3, lines 4-6; col. 17, lines 13-21; col. 17, lines 39-44.² The Examiner utilizes this rationale with respect to each of the remaining claims rejected under 35 U.S.C. § 103 as being obvious over the hypothetical combination of Hoyle and Hetherington.

Obviousness Rejection of Claim 18

Claim 18 depends indirectly from independent claim 16, which, as discussed above, has been amended to overcome the rejection over Hoyle. The arguments presented in connection with claim 16 apply here as well. Because Hoyle does not teach or suggest all of the claimed limitations of claim 18, and because neither Hetherington nor any other reference supply the missing elements as claimed, the rejection under 35 U.S.C. § 103 should be withdrawn.

Obviousness Rejection of Claims 20, 27, 37, 41, and 45

(a) Claims 20, 27, 37, 41, and 45 Have Been Amended In a Fashion Consistent With Claims 1, 8, and 15, And, Therefore, Hoyle Neither Teaches Nor Suggests The Methods And

² The above explanation by the Examiner once again illustrates some confusion with respect to the Examiner's usage of the term "preference parameter". As set forth above in footnote 1, the preference parameter is some identifier indicating a particular group of resources that are needed to effect a chosen language by a user.

Systems Of Claims 20, 27, 37, 41, and 45 As Asserted By The Examiner And Is Not Sufficient As A Base Reference For The Obviousness Rejection.

As explained in M.P.E.P § 2143, “the prior art reference (or references when combined) must teach or suggest all the claim limitations” set forth in the rejected claims. The teaching or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant’s disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

With respect to the usage of Hoyle as a base reference for the present obvious rejection, applicant submits that in light of the arguments set forth above and the amendments to independent claims 20, 27, 37, 41, and 45, Hoyle neither teaches nor suggests the system and method for changing a language preference of a downloadable tool bar application interface that is integrated into a browser application user interface as set forth in the claims. Thus, even if Hetherington teaches the language customization, as asserted by the Examiner, which it does not as described further below, the hypothetical combination of Hoyle and Hetherington does not teach or suggest all of the limitations of the rejected claims as required, and thus cannot sustain a § 103 rejection.

Specifically, Hoyle fails to teach or suggest at least (i) a downloadable toolbar application that has a toolbar interface that is integrated into and becomes a part of a browser application user interface, (ii) the receipt of a message at the server system to change the language attribute of the toolbar interface in response to a change in user preference, (iii) the transmission of a preference parameter associated with a group of resources needed to effect the requested change in language attribute, and (iv) the determination using the preference parameter as to whether the needed group of resources is stored locally at the client computer.

Thus, because Hoyle fails to teach or suggest several features of claims 20, 27, 37, 41, and 45, Hoyle cannot be used as a base reference to rejected the claims under 35 U.S.C. § 103.

Accordingly, Applicant submits that the rejection has been overcome and the claims are in condition for allowance.

(b) *There Is No Motivation In Hoyle To Suggest The Hypothetical Combination Made By The Examiner.*

Applicant submits that there is no motivation in Hoyle to suggest any customization of a language setting of the software application 10. The Examiner appears to contend that the correction of demographic data about users somehow suggests that modifying the software application to permit a change in language of the software application interface. However, contrary to the Examiner's assertions, this demographic data is used solely to target advertising to the user. Thus, there is no teaching or suggestion in Hoyle that the interface of the Hoyle software application 10, or any software application can be or should be modified to permit a user to change the language setting of the interface, such that the interface displays text and graphics in a language other than the original language that the software application was downloaded in.

Moreover, with respect to the embodiment of Hoyle describing the modular updating of software application 10, the updating process is discussed solely in connection with version and advertising updates and makes no mention whatsoever of updating the software application to include an alternate interface language setting.

As such, applicants respectfully submits that the Examiner has not sufficiently pointed to any teaching or suggestion within the Hoyle reference that would motivate one of ordinary skill in the art to modify Hoyle to include features of Hetherington as required by the law of obviousness. See M.P.E.P. § 2143.01; see also In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (a combination of the references taught every element of the claimed invention, however, without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper).

Thus, the use of demographic data to target advertising in the form of graphical banner ads neither explicitly nor implicitly teaches or suggests modifying a language setting of the software application itself as set forth in the rejected claims. Accordingly, for this reason alone, applicant respectfully submits that the obviousness rejection should be withdrawn.

(c) Hoyle and Hetherington Are Non-Analogous References And, Therefore, There Is No Motivation To Suggest The Hypothetical Combination Made By The Examiner.

There is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner in the Final Rejection, and thus, the combination of Hoyle and Hetherington is improper.

Whereas Hoyle is primarily directed to a method of targeting advertising to users in an internet environment, Hetherington is directed to a method and system for changing the language of an application using system commands to alter the language and locale settings for the user interface of the application. Furthermore, because Hetherington is directed to a system for remotely controlling another user's software application, there is no motivation in Hetherington to make the hypothetical combination suggested by the Examiner. In Hetherington, the Information Systems (IS) department of a multinational corporation can remotely control and/or perform diagnostic work on a remote user's software applications in the IS department's native language, which is clearly not the user's purpose. This is accomplished by the sending of a system command to change the remote user's language preference for the software application in question. See Hetherington, FIG. 4. Thus, the system commands of Hetherington are not indicative of a change in the user's preference, but rather of a need for a remote user to view the application in his/her native language. The use of system commands to change a language setting in a remote application control environment would not motivate a person of ordinary skill to combine the teachings of Hetherington with the non-analogous targeted advertising system of Hoyle. Thus, because there is no motivation in Hetherington to make the hypothetical

combination and because these reference are not directed to analogous fields of endeavor, the proposed combination is improper.

Further, in the Final Rejection, the Examiner presents no motivation or suggestion in the references themselves that persons of skilled in the art would be motivated to combine the references as suggested by the Examiner. Applicant submits that even if the hypothetical combination taught the invention as claimed (which the combination does not), the combination presented by the Examiner involves impermissible hindsight reconstruction of the invention wherein the Examiner has arbitrarily picked and chosen from various descriptions in the prior art in an attempt to arrive at the claimed invention. See Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907 (Fed. Cir. 1988).

(d) Hetherington Does Not Teach The Claimed Process Of Updating The Resources Of A Downloadable Toolbar Application To Effect A Change In Language Preference.

Hetherington describes the use of system commands transmitted between computers on a network to effect a change of the language setting of an application. From Hetherington's disclosure it is clear that the resources necessary to effect the language setting change in response to receipt of the system commands are already hard-coded into the subject software application.

In contrast, the method and system of claims 20, 27, 37, 41, and 45 requires a determination as to whether the resources needed to effect the language change are stored locally and, if not, downloading the resources from a remote server system. This is entirely different from the language change system of Hetherington. Thus, Hetherington does not teach the language changing method and system of claims 20, 27, 37, 41, and 45.

Thus, because Hoyle as the cited base reference does not contain the teaching suggested by the Examiner, because the proposed hypothetical combination is improper, and because all of the claimed elements are not present even if the combination were proper, applicant submits that

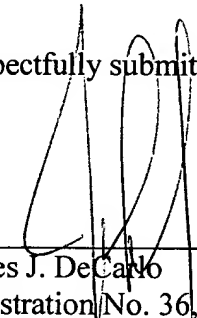
the rejection of claims 20, 27, 37, 41, and 45 should be withdrawn. Further, because claims 21, 28-29, 38-40, 42-44, and 46-49 depend from independent claims 20, 27, 37, 41 and 45, respectively, Applicant submits that said dependent claims are also in condition for allowance.

CONCLUSION

Applicant has considered the prior art of record, and respectfully submits that none of the references relied upon by the Examiner in rejecting the claims of the present application, considered alone or in any hypothetical combination (between and among each other or with the knowledge of a person of ordinary skill in the art), teach or suggest applicant's invention, as recited by the claims of the present application.

Early and favorable consideration of the present application in view of the amendments to the claims and remarks provided herein is respectfully requested. If the Examiner is not in a position to allow all claims as presently amended, the Examiner is urged to call the undersigned attorney at 212-806-5400. Any additional fees or charges required at this time or in the future in connection with the present application are hereby authorized to be charged to Deposit Account No. 19-4709.

Respectfully submitted,



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